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In re Application of
JOUISHOMME, Herve, et al.
Application No.: 09/980,080
PCT No.: PCT/CA00/00650
Int. Filing Date: 02 June 2000
Priority Date: 03 June 1999
Attorney Docket No.: PGI-1
For: 3-DIMENSIONAL IN VITRO MODELS
OF MAMMALIAN TISSUES

DECISION ON

PETITION UNDER

37 CFR 1.47(a)

This is a decision on applicants' "Renewed Petition Under 37 CFR 1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 25 October 2002.

BACKGROUND

On 02 June 2000, applicants filed international application PCT/CA00/00650, which claimed a priority date of 03 June 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 14 December 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 December 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 03 December 2001.

On 30 November 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 18 January 2002, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 20 May 2002, applicants submitted the instant petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a combined declaration and power of attorney executed, a petition for a two month extension of time and the fee for a two month extension of time.

On 25 June 2002, the Office mailed Decision on Petition Under 37 CFR 1.47(a) dismissing the petition without prejudice.

On 25 October 2002, applicants submitted "Renewed Petition Under 37 CFR 1.47(a)".

DISCUSSION

When a joint inventor cannot be located or refuses to sign the oath or declaration, a petition under 37 CFR 1.47(a) must accompany the oath or declaration. 37 CFR 1.47(a). A petition under 37 CFR

1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Item (1) was previously met.

Item (4) has now been met. The declaration complies with 37 CFR 1.497(a)-(b).

As to item (2), applicants claim to be unable to locate the nonsigning inventor, but according to the statement of facts, a 37 CFR 1.47(a) applicant, Ms. Phipps, knows the location of Inventor Herve Jouishomme, but is unwilling to disclose it. Applicants cannot claim that the inventor cannot be located *after a diligent effort* when one of the applicants knows the inventor's location, but has chosen not to disclose it. Applicants may still base a petition under 37 CFR 1.47(a) on the refusal of applicant to execute the declaration, but then applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers to the inventor. MPEP 409.03(d).

It is noted that parts of the statement of facts were hearsay. Namely, Mr. Anderson did not personally prepare the package for mailing nor did he conduct the internet search for the nonsigning inventor. The statements must be signed by someone with first hand knowledge of the facts recited therein, whenever possible. MPEP 409.03(d).

As to item (3), as applicants indicate that Ms. Phipps knows the current address of the nonsigning inventor and will not disclose it, it is possible that the address provided is not the last known address.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is DISMISSED, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



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